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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,421	09/27/2001	Syed F.A. Hossainy	50623.60	6381

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EXAMINER

NGUYEN, VI X

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 04/27/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/966,421

Applicant(s)

HOSSAINY, SYED F.A.

Examiner

Victor X Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-13, 29, 30 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-13, 29, 30 and 45 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. In response to applicant's amendment of 1/29/2004, the examiner has removed all prior 35 USC § 112 rejections.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 11-13 and 45 are rejected under 35 U.S.C. 102 (b) as being anticipated by Fearnot et al (U.S. 5,609,629).

Fearnot et al show in figures 1 and 5, a stent or other implantable medical device (see col. 4, lines 48-60) that releases drug into the vascular system having the limitations of claims 1 and 45, including: a first material (labeled in col.12, lines 34-40) carried by the stent (12). A second material (col.4, lines 48-60) carried by the stent that is configured to convert a first type of energy to a second type of energy (col. 4, lines 13-16). In fact, Fearnot discloses that at least one porous layer can be applied by plasma deposition which can be considered as the second material. Fearnot does so to indicate that the plasma is able to convert electrical energy to chemical energy. Regarding the intended use of a stent for delivering a therapeutic substance; a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use,

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then it meets the claim. In the instant case, the stent of Fearnot et al would have been capable of performing the use as claimed.

Regarding claims 2-4, wherein the second material is selected from the group consisting of Au (labeled in col.4, lines50-51). The second type of energy is thermal energy; and wherein the second material is disposed in microdepots (col.14, lines 22-29).

Regarding claims 5-6, wherein a topcoat (18) deposits over a portion of the first material; and wherein the second material includes Au particles (col.4, lines50-51).

Regarding claims 7-8, Fearnot et al disclose that the stent (12) as seen on figs. 1 and 5 is capable of using more than one materials configured to convert more than one energy (see col. 4, lines 13-46).

Regarding claims 11-13, wherein the first material is hydrogel (col.12, lines 34-40) which is selected from polypeptides and mixtures thereof (col. 14, lines 45-51).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-30 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Fearnot'

629. Fearnot' is silent regarding the diameter of Au particles having a silica nanoparticle from 100 to 250 nm or having a thickness of 1 to 100 nm. Nevertheless, Fearnot does disclose Au particles, which must be changed in the size of a component involve merely routine skill in the art. Therefore, it would have been obvious to one of ordinary skill in

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the art at the time the invention was made to make Fearnot' the diameter of Au particles having a silica nanoparticle from 100 to 250 nm or having a thickness of 1 to 100 nm.

***Allowable Subject Matter***

4. Claims 9-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose or suggest all of the limitations of claims 9-10 including, the first type of energy is non-cytotoxic electromagnetic waves. The second material has electromagnetic waves with wavelengths between 800 and 1200 nm into thermal energy.

***Response to Amendment***

5. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection. Applicant is asked to please refer to the modified prior art rejection above wherein examiner addresses applicant's concerns regarding prior art rejections. For example, Fearnot et al show in figures 1 and 5, a stent or other implantable medical device (see col. 4, lines 48-60) that releases drug into the vascular system having the limitations of claims 1 and 45, including: a first material (labeled in col.12, lines 34-40) carried by the stent (12). A second material (col.4, lines 48-60) carried by the stent that is configured to convert a first type of energy to a second type of energy (col. 4, lines 13-16). In fact, Fearnot discloses that at least one porous layer can be applied by plasma deposition which can be considered as the second material. Fearnot does so to indicate that the plasma is able to convert electrical energy to chemical energy. Regarding the intended use of a stent for delivering a therapeutic substance; a recitation of the intended use of the claimed invention must result in a

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structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the stent of Fearnot et al would have been capable of performing the use as claimed. Therefore, at least claim 1 of the invention is not defined over the Fearnot'629 reference.

Newly submitted claims 31-44 are directed to an invention that is dependent from non-elected invention for the following reasons: originally presented claims 1-13 were related to Species 3, Group 1 for fig. 6 (which was elected in Paper #6). While newly submitted claims are directed to Group III-IV of fig. 2, which Groups are distinct from the originally claimed. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively by original presentation for prosecution on the merits. Therefore, **claims 31-44 are withdrawn from consideration** as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### *Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen  
Examiner  
Art Unit 3731

Vn  $\checkmark$   
April 22, 2004

  
MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
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